REMARKS

Claims 1, 4-9, 11-13, 16-25 and 28-43 are pending in the present application. By this Response, claims 1, 9, 13, 21, 22, 25, 33 and 34 are amended, claims 2-3, 10, 14-15 and 26-27 are canceled, and claims 37-43 are added. Claim 1 is amended to incorporate the subject matter of claims 2-3 and 10. Claim 13 is amended to incorporate the subject matter of claims 14-15. Claim 25 is amended to incorporate the subject matter of claims 26-27. Claims 9, 21 and 33 are amended to correct their dependency in view of the cancellation of claims. Claims 22 and 34 are amended for clarification purposes only. Reconsideration of the claims in view of the above amendments and the following remarks is respectfully requested.

I. Telephone Interview

Applicants thank Examiner Mooneyham for the courtesies extended to Applicants' representative during the July 22, 2004 telephone interview. During the interview, Applicants' representative discussed the above amendments to the claims and the distinctions of the claims over the cited references. Examiner Mooneyham agreed that the above amendments to the claims overcomes the rejections under 35 U.S.C. § 112, second paragraph and 35 U.S.C. § 101. The substance of the interview is summarized in the following remarks.

II. 35 U.S.C. § 112, Second Paragraph and 35 U.S.C. § 101

The rejections of the claims under 35 U.S.C. § 101 and 112, second paragraph have been overcome by the amendments to the claims above as agreed by the Examiner during the July 22, 2004 telephone interview. Accordingly, Applicants respectfully request withdrawal of the rejection of the claims under 35 U.S.C. § 101 and 112, second paragraph.

III. 35 U.S.C. § 103, Alleged Obviousness Based on Schultz

The Office Action rejects claims 1, 2, 13, 14, 25, and 26 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Schultz (U.S. Patent Application Publication No. 2001/0056391). This rejection is moot with regard to canceled claims 2, 14 and 26 and is respectfully traversed with regard to claims 1, 13 and 25.

As to independent claims 1, 13 and 25, the Office Action states:

> Schultz discloses a method, apparatus, and program for estimating the impact on a user comprising:
> obtaining proposed data (Fig. 1 (110); and
> calculating an affect, (Fig. 1); and
> outputting the affect (page 12, claim 15, displaying the estimate)
> Schultz does not disclose that the data is proposed legislation. However, this difference is nonfunctional descriptive data since the data does not alter or reconfigure the system or method steps The system and the method would perform the same regardless of the type data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994)
> Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made obtain proposed legislative data, calculate and output the affect because such data does not functionally relate to the structure or steps and because the subjective interpretation of data does not patentably distinguish the claimed invention.

Office Action dated May 7, 2004, pages 3-4.

Claim 1, which is representative of the other rejected independent claims 13 and 25 with regard to similarly recited subject matter, reads as follows:

> 1. A method, in a data processing system, for estimating an impact of proposed legislation on a user, comprising:
> obtaining proposed legislation data from a server computing device;

calculating, in a client computing device, an affect of the proposed legislation based on the proposed legislation data; and

outputting, via the client computing device, the affect of the proposed legislation, wherein the proposed legislation data represents proposed changes to a tax code, and wherein calculating an affect of the proposed legislation includes calculating an estimated change in tax liability by:

calculating an estimated tax liability based on the proposed legislation data; and

comparing the estimated tax liability to a previous tax liability. (emphasis added)

Schultz does not teach or suggest a method of estimating an impact of proposed changes to a tax code in which an affect of the proposed changes to the tax code is calculated by calculating an estimated change in tax liability by calculating an estimated tax liability based on the proposed legislation data and comparing it to a previous tax liability. To the contrary, Schultz is directed to determining whether to exercise a stock option or not.

Schultz teaches a method and apparatus for managing and optimizing stock options. As illustrated in Figure 1 of Schultz, the method of Schultz involves receiving an option-exercising scenario, calculating an estimated for the option-exercising scenario, comparing the calculated estimate against an estimated for a standard strategy option-exercising scenario, receiving subjective data, and then calculating an optimal strategy for a selected option-exercising scenario. With the system of Schultz, a user may log on and review their current stock option grants. The users may build option-exercising scenarios, develop optimal strategies, and maximize potential values of their grants. By modeling option exercise scenarios and forecasts, the user can see the consequences of exercising, selling, or holding their options, including the tax implications [page 2, paragraph 31].

Thus, while Schultz mentions "tax implications" with regard to the exercising, selling or holding of stock options, Schultz is not concerned with determining the affect of proposed legislation that is a change to a tax code. Moreover, nowhere in Schultz is there any teaching or suggestion regarding

calculating an estimated change in tax liability based on a proposed change to the tax code or comparing this estimated tax liability with a previous tax liability to obtain an affect of the proposed change to the tax code.

To the contrary, Schultz is concerned with setting up various scenarios regarding exercising of stock options to see what is the best scenario to achieve the goals of a particular stock option holder. While Schultz may forecast the consequences of exercising stock options so that the forecast may be compared with other scenarios available to the stock option holder, Schultz does not provide any teaching or suggestion regarding estimating the affect of proposed legislation, i.e. legislation that has not yet been enacted into law, let alone proposed changes to a tax code. Moreover, even though Schultz may calculate the consequences of exercising, holding or selling stock options, nowhere in Schultz is there any teaching or suggestion regarding calculating an estimated change in tax liability by calculating an estimated tax liability based on proposed legislation data and comparing the estimated tax liability to a previous tax liability.

Thus, Schultz does not teach or suggest the features recited in independent claims 1, 13 and 25. Moreover, the Office Action admits that Schultz does not teach proposed changes to a tax code [Office Action, page 4] or that calculating the affect of proposed legislation includes calculating an estimated change in tax liability by calculating an estimated tax liability [Office Action, page 5]. Therefore, Applicants respectfully request withdrawal of the rejection of independent claims 1, 13 and 25 under 35 U.S.C. § 103(a).

IV. 35 U.S.C. § 103, Alleged Obviousness Based on Schultz and Miller

The Office Action rejects claims 3-12, 15-24, and 27-36 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Schultz in view of Miller (U.S. Patent No. 6,202,052). This rejection is respectfully traversed.

The subject matter of claims 3, 15 and 27 has been incorporated into independent claims 1, 13 and 25, respectively, and claims 3, 15 and 27 have been

cancelled accordingly. Therefore, the subject matter of claims 3, 15 and 27 will be addressed with regard to independent claims 1, 13 and 25.

Neither Schultz nor Miller, either alone or in combination, teach or suggest the features of independent claims 1, 13 and 25. As set forth above, Schultz does not teach or suggest a method of estimating an impact of proposed changes to a tax code in which an affect of the proposed changes to the tax code is calculated by calculating an estimated change in tax liability by calculating an estimated tax liability based on the proposed legislation data and comparing it to a previous tax liability. Furthermore, the Office Action has admitted that Schultz does not teach these features. However, the Office Action alleges these features are obvious in view of the teachings of Miller.

Miller is directed to a fully-automated system for tax reporting, payment and refund. Miller is directed to the filing of tax returns, i.e. filing forms under the current tax code. Miller is not directed to determining the affect of proposed changes to the tax code by calculating an estimated change in tax liability. Moreover, nowhere in Miller is there any teaching of calculating an estimated tax liability based on proposed legislation data, wherein the proposed legislation data represents changes to a tax code, and then comparing the estimated tax liability to a previous tax liability. To the contrary, Miller merely obtains tax information from various sources for a particular tax payer and automatically fills out the proper tax forms and files them with the IRS. Miller has nothing to do with proposed changes to legislation or proposed changes to a tax code.

Nowhere in either of the Schultz or Miller references is there any teaching or suggestion regarding obtaining proposed legislation data that is representative of a change in a tax code or estimating a change in tax liability by calculating an estimated tax liability based on the proposed legislation data and comparing it to a previous tax liability. Therefore, any alleged combination of Schultz and Miller, even if such a combination were possible, arguendo, would not result in the invention as recited in independent claims 1, 13 and 25. To the contrary, a combination of Schultz and Miller would result in a system in which the affect of exercising stock options on a taxpayers' tax liability may be determined and

appropriate forms filled out and filed. However, the affect of exercising the stock options would still be determined under the existing tax code. The combination of Schultz and Miller would still not address the problem of determining the affect of proposed changes to a tax code on a user's tax liability and still would not result in a method, system or computer program product in which a change in tax liability is estimated by calculating an estimated tax liability based on proposed legislation data and comparing the estimated tax liability to a previous tax liability.

Furthermore, Applicants respectfully submit that one of ordinary skill in the art would not be motivated to even attempt to combine Schultz with Miller. Schultz is directed to a system for informing a user of the results of various scenarios related to the exercising of stock options. Miller is directed to a system for automatically filling out tax forms and filing them with the IRS. While the exercising of stock options has tax consequences, there is no reason why one of ordinary skill in the art would look at Schultz and determine that it would be beneficial to combine the stock option exercising information system of Schultz with a tax form filing system of Miller. To the contrary, Schultz is directed to permitting a user to explore the various scenarios that may be available to them with regard to their stock options. Miller is directed to filing tax returns. A person trying to decide how to exercise their stock options does not necessarily want to immediately file a tax return so then why would they want to combine Schultz with Miller?

Basically, there is no suggestion in either reference to combine it with the other reference. This is because the references are directed to two completely different technological areas. Thus, the only way in which one of ordinary skill in the art would be motivated to even attempt to combine the references is if that person first had benefit of Applicants' claimed invention and the sole purpose of attempting to recreate Applicants' claimed invention. This is impermissible hindsight reconstruction using Applicants' disclosure as a guide. While Applicants understand that all examination involves a measure of hindsight when finding references, once those references are found, the Examiner must

objectively determine whether one of ordinary skill in the art, presented only with these references, and without having any knowledge of Applicants' claimed invention, necessarily combine them in the particular way necessary and modify them in the particular way necessary to arrive at Applicants' claimed invention. In the present case, the answer is clearly "no." Thus, the only basis for the rejection of claims 1, 13 and 25 is a hindsight reconstruction which is an impermissible basis for making a rejection under 35 U.S.C. § 103(a).

Therefore, in view of the above, Applicants respectfully submit that neither Schultz nor Miller, taken alone or in combination, teach or suggest the features of independent claims 1, 13 and 25. At least by virtue of their dependency on claims 1, 13 and 25, respectively, neither Schultz nor Miller, either alone or in combination, teach or suggest the features of dependent claims 4-9, 11-12, 16-24 and 28-36. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 4-9, 11-12, 16-24 and 28-36 under 35 U.S.C. § 103(a).

In addition, neither Schultz nor Miller, either alone or in combination, teach or suggest the specific features recited in dependent claims 4-9, 11-12, 16-24 and 28-36. For example, with regard to claims 4, 16 and 28, neither reference teaches or suggests generating an electronic mail message based on the affect of the proposed legislation or transmitting the electronic mail message to one or more remote devices. The Office Action merely takes "Official Notice" that it is old and well known to transmit data in an email message. While this may be so, it is not "old and well known" to transmit an email message based on the affect of proposed legislation as determined by the mechanisms of claims 1, 13 and 25. That is, simply stating that email is old and well known does not address the actual features of claims 4, 16 and 28 which is the generating and transmitting of an email message based on the affect of the proposed legislation (which was determined from the mechanisms recited in claims 1, 13 and 25). Thus, the Examiner's taking of "Official Notice" does not set forth a prima facie case of obviousness with regard to the features of claims 4, 16 and 28 since the Examiner has failed to address the specific features recited in these claims.

Regarding claims 5, 17 and 29, neither reference teaches or suggests an email that indicates one of a user's support or non-support of the proposed legislation. The Office Action regards this feature as "nonfunctional descriptive material." Applicants respectfully disagree.

The recitation of whether the email indicates one of the users support or nonsupport of the proposed legislation is a feature directed to the type of email that is generated based on the affect of the proposed legislation in claims 4, 16 and 28. That is, if the affect of the proposed legislation is beneficial, then an email in support of the legislation will be generated and transmitted. If the affect of the proposed legislation is not beneficial, then an email indicating non-support of the legislation will be generate and transmitted. Thus, the feature of the email indicating either support or non-support of the proposed legislation is not merely "nonfunctional descriptive material" and has the function of informing the recipient of the email of the senders support or non-support of the proposed legislation based on the determined affect of the proposed legislation. Therefore, the Examiner's holding of the features of claims 4, 16 and 28 to be "nonfunctional descriptive material" is in error and furthermore, does not establish a prima facie case of obviousness.

Furthermore, the Office Action fails to state why it would be obvious to include such features in the systems of Schultz and Miller. This is because there is no reason to include a feature of generating an email message and transmitting it based on a determined affect of proposed legislation where the email message indicates support or non-support of the proposed legislation in either reference. Schultz is directed to exercising stock options. Miller is directed to filing tax returns. Neither deals with proposed legislation and thus, there is no reason why one would include the ability to generate emails in support or non-support of proposed legislation based on a determined affect of the proposed legislation in either of these references.

Regarding claims 6, 18 and 30, neither reference teaches or suggests the automatic generation of an electronic mail message based on the affect of proposed legislation. Once again, rather than actually finding this feature

anywhere in any of the references, the Examiner merely takes "Official Notice" that it is old and well known to automatically generate emails when "certain data is created." While this may be so, it is not "old and well known" to automatically generate email messages based on the affect of proposed legislation as determined using the mechanisms of claims 1, 13 and 25. Thus, simply taking "Official Notice" that automatic emails are known does not actually address the features of claims 6, 18 and 30. Thus, the Examiner has once again failed to set forth a prima facie case of obviousness with regard to claims 6, 18 and 30.

Moreover, once again, the Examiner has failed to address why it would be obvious to include the automatic generation of emails based on the determined affect of proposed legislation in the systems of Schultz and Miller. This is because there is no reason to include a feature of automatically generating an email message and transmitting it based on a determined affect of proposed legislation. Neither reference deals with proposed legislation and thus, there is no reason why one would include the ability to automatically generate emails based on a determined affect of the proposed legislation in either of these references.

Regarding claims 7, 19 and 31, neither reference teaches or suggests automatically inserting the affect of proposed legislation into an email. The Office Action states that the data in the email being an affect of proposed legislation is nonfunctional descriptive material. To the contrary, the affect of the proposed legislation is the result of the operations and mechanisms recited in independent claims 1, 13 and 25. The affect of the proposed legislation is information indicative of the way in which the proposed legislation will change the tax liability of the user. Thus, it is not "nonfunctional descriptive material."

Furthermore, the Office Action fails to even cite any reference that sends emails, even with such "nonfunctional descriptive material" in it, based on the affect of the proposed legislation as determined using the operations and mechanisms of claims 1, 13 and 25. Neither Schultz nor Miller send any email messages at all based on a determined affect of proposed legislation, i.e. changes in a tax code. Thus, even if these features of claims 7, 19 and 31 are disregarded

as "nonfunctional descriptive material," the references cited do not teach or suggest any of these features.

With regard to claims 8, 20 and 32, similar arguments to those set forth above with regard to the email features of the present invention apply to the Office Action's rejection of claims 8, 20 and 32. Once again, rather than actually finding this feature in any reference, the Examiner merely takes "Official Notice" that it is old and well known to transmit email messages to one or more remote devices automatically. While this may be true, it is not old and well known to automatically transmit email messages to one or more remote devices where the email is generated based on the determined affect of proposed legislation as determined in the manner set forth in independent claims 1, 13 and 25. The Examiner must examine the claims as a whole and not just reject a piece of the claimed invention without taking into consideration the way in which that piece fits in with the rest of the claimed invention.

As with all of the other rejections of the independent claims, the Examiner is involved in piecemeal analysis of the claims without any regard for the claimed invention as a whole. That is, rather than rejecting claim 8, for example, as including all of the features of claims 1, 4 and 8, as the Examiner should, the Examiner merely addresses the feature of "transmitting email messages to one or more remote devices automatically" in a vacuum without any regard for the other features of the claim and how this addressed feature fits in with the other features of the claim. The rejection of claims 8, 20 and 32 does not even address the combination of Schultz and Miller and does not show why, even if the automatic addressing of email messages to one or more remote devices were known, it would be obvious to combine such a feature with those teachings of Schultz and Miller. Thus, the Office Action has again failed to establish a prima facie case of obviousness with regard to claims 8, 20 and 32.

Regarding claims 9, 21 and 33, neither reference teaches or suggests updating a tax calculation engine based on the proposed legislation data. The Office Action alleges that Miller teaches this feature in Figure 2 item 27 which is labeled "taxing authorities." The taxing authority in Figure 2 is the IRS, for

example. Merely teaching the IRS or other taxing authority has nothing to do with updating a tax calculation engine based on proposed legislation data. To the contrary, Miller works entirely within a current tax code and has nothing to do with proposed changes to a tax code or proposed legislation data. Thus, merely pointing to a box in a figure of Miller that is labeled "taxing authority" does not establish a prima facie case of obviousness with regard to the features of claims 9, 21 and 33.

The other dependent claims recite additional features that, when taken in combination with the features of the claims from which they depend, are not taught or suggested by Schultz and Miller. Therefore, dependent claims 4-9, 11-12, 16-24 and 28-36 are allowable over the alleged combination of Schultz and Miller by virtue of their dependency and also by virtue of the specific features recited in these claims.

V. Newly Added Claims

Claims 37-43 are added to recite additional features of the present invention. The subject matter of claims 37-43 is supported by the present specification at least based on the originally filed claims. No new matter has been added by the addition of claims 37-43. Neither Schultz nor Miller, either alone or in combination, teach or suggest the features of claims 37-43.

VI. Conclusion

It is respectfully urged that the subject application is patentable over Schultz and Miller and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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